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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,957	10/11/2001	Masayuki Kushita	14987	7585
23389	7590	06/07/2004	<input type="text"/> EXAMINER PHAN, JOSEPH T	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			<input type="text"/> ART UNIT 2645	<input type="text"/> PAPER NUMBER
DATE MAILED: 06/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/974,957	KUSHITA, MASAYUKI
	Examiner Joseph T Phan	Art Unit 2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 March 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 2-4,6-10,12-14 and 16-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 2-4,6-10,12-14 and 16-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The information disclosure statement filed 10/11/01 has been considered.

The information disclosure statement filed 04/22/04, paper #5 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language.

Applicant's submittal of the IDS's relevance is limited(2-3 lines). Examiner needs a more concise explanation of the relevance and/or translation of the document to be able to consider.

It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4, 7-8, 13-14, and 17-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-4, 7-8, 13-14, and 17-18 recite "...the prescribed period of time" at the end of the claims. It is unclear and not known which time "...the prescribed period of time" is referring to.

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Claim 17 line 15 and 18 lines 17-18 recite “..the transmission” It is unclear and not known if this phrase refers to the transmission of “..the reading out the text data” or the “... supplying of the text data to the text-to-speech converter” or the “... sending of the converted audio data to the radio..”

Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

a. **Claims 2, 3-4, 6-10, 12-14, and 16-18 rejected under 35 U.S.C. 102(e)**  
**as being anticipated by Zahavi, et al., Patent #6,577,859.**

b. **Claims 2, 3-4, 6-10, 12-14, and 16-18 rejected under 35 U.S.C. 102(b)**  
**as being anticipated by Pepe et al., Patent #5,742,905.**

Regarding claim 2, Zahavi or Pepe teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of a called party when calling up as claimed in claim 3, wherein contents of the reproduced audio data are displayed on a display as text data during the transmission (Zahavi Fig.2; Pepe Fig.45).

Regarding claims 3 and 4, Zahavi or Pepe teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of a called party when calling up comprising the steps of:

receiving a signal sent from a base station corresponding to a response of the called party to a call setup operation from a key-input section of a cellular phone (Zahavi col.3 lines 36-col.4 line 8; Pepe Fig.1 and col.21 lines 45-54);

reproducing audio data previously recorded and stored in a memory or synthetic audio data previously stored in a memory (Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54)

transmitting the reproduced audio data to the called party via a radio transmitter/receiver(Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54 and col.29 line 26-col.30 line 56/cell phone or PDA is a radio transmitter/receiver);

wherein contents of the reproduced audio data are displayed on a display as text data during the transmission (Zahavi Fig.2; Pepe Fig.45); and

automatically terminating the call or disconnecting after the reproduction and transmission of the audio data are completed(Zahavi col.5 lines 15-51; Pepe col.21 lines 45-54 ; Examiner chooses to use "or" in interpretation therefore the call in Zahavi and Pepe is disconnected after the transmission of audio),

wherein the reproduction of the audio data can be designated during the call including the prescribed period of time (Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54).

Regarding claim 6, Zahavi or Pepe teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the called party when calling up as claimed in claim 7, wherein contents of the text data are displayed on a display during the transmission(Zahavi Fig.2; Pepe Fig.45).

Regarding claim 7, Zahavi or Pepe teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the a called party when calling up

comprising the steps of receiving a signal sent from a base station corresponding to a response of the called party to a call setup operation from a key-input section of a cellular phone(Zahavi col.3 lines 36-col.4 line 8; Pepe Fig.1 col.21 lines 45-54); reading out text data stored in a memory(Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54);

converting the text data into audio data at a text-to-speech converter (Zahavi col.4 lines 43-51 and col.6 lines 1-39; Pepe col.29 lines 56-64)

transmitting the converted audio data to the called party via a radio transmitter/receiver(*Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54 and col.29 line 26-col.30 line 56/cell phone or PDA is a radio transmitter/receiver*); and

automatically terminating the call or disconnecting after the transmission of the audio data is completed(*Zahavi col.5 lines 15-51; Pepe col.21 lines 45-54* ;

*Examiner chooses to use “or” in interpretation therefore the call in Zahavi and Pepe is disconnected after the transmission of audio*),

wherein the readout of the text data can be designated during the call including the

prescribed period of time (Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54).

Regarding claim 8, Zahavi or Pepe teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of a called party when calling up comprising: the steps of receiving a signal sent from a base station corresponding to a response of the called party to a call setup operation from a key-input section of a cellular phone(Zahavi col.3 lines 36-col.4 line 8; Pepe Fig.1 col.21 lines 45-54);

reading out text data stored in a memory converting the text data into audio data at a text-to-speech converter(Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54); transmitting the converted audio data to the called party via a radio transmitter/receiver(*Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54 and col.29 line 26-col.30 line 56/cell phone or PDA is a radio transmitter/receiver*); and automatically terminating the call or disconnecting after the transmission of the audio data is completed, wherein contents of the text data are displayed on a display during the transmission, and wherein the readout of the text data can be designated during the call including the prescribed period of time(*Zahavi col.5 lines 15-51; Pepe col.21 lines 45-54; Examiner chooses to use "or" in interpretation therefore the call in Zahavi and Pepe is disconnected after the transmission of audio*).

Regarding claim 9, Zahavi or Pepe teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of a called party when calling up as claimed in claim 7, further comprising the steps of:

indicating completion of the transmission on the display after the transmission of the converted audio data is finished; reading out another item of text data stored in the memory and supplying the text data to the text-to-speech converter while retaining the call; converting the text data into audio data at the text-to-speech converter; and sending the converted audio data to the radio transmitter/receiver in successio(*Zahavi col.5 lines 15-51; Pepe col.21 lines 45-54*).

Regarding claim 10, Zahavi or Pepe teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the a called party when calling up as claimed in claim 8, further comprising the steps of:  
a means for designating the reproduction of the audio data during the call including the prescribed period of time(*Zahavi col.5 lines 15-33; Pepe col.21 lines 45-54*).

Regarding claim 16, Zahavi or Pepe teaches a cellular phone as claimed in claim 17, further including a means for displaying contents of the text data on a display during the transmission (*Zahavi Fig.2; Pepe Fig.45*).

Regarding claim 17, Zahavi or Pepe teaches, as best understood due to the 112 issues above a cellular phone comprising:

a key-input section for inputting a telephone number when making a phone call, a text-entry and settings for respective functions(*Zahavi col.5 lines 63-67; Pepe Fig.41-Fig.44*);

a radio transmitter/receiver for communicating with a base station by radio and memories for storing inputted character data as text data(*Zahavi Fig.2, col.5 line 15-col.6 like 39; Pepe Fig.1 and Fig.41-Fig.44*);

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a text-to-speech converter for converting the text data into audio data (Zahavi col. 5 line 15-col.6 line 39; Pepe col.21 *lines 45-54 and col.29 line 26-col.30 line 56*); a controller which includes: a means for originating a call of a telephone number when the telephone number and a call up setup are inputted from the key-input section, a means for reading out the text data stored in one of the memories on receipt of a signal sent from the base station corresponding to a response of a called party to the call and supplying the text data to the text-to-speech converter in order to convert the text data to audio data, a means for sending the converted audio data to the radio transmitter/receiver, and a means for terminating the call or disconnecting after the transmission of the converted audio data is completed and a means for designating the readout of the text data during the call including the prescribed period of time(Zahavi Fig.2 col. 5 line 15-col.6 line 39; Pepe Fig.1 col.21 *lines 45-54 and col.29 line 26-col.30 line 56*).

Regarding claim 18, Zahavi or Pepe teaches, as best understood due to the 112 issues above, a cellular phone comprising:

a key-input section for inputting a telephone number when making a phone call, a text-entry and settings for respective functions(Zahavi col.5 lines 63-67; Pepe Fig.41-Fig.44);

a radio transmitter/receiver for communicating with a base station by radio and memories for storing inputted character data as text data(Zahavi Fig.2, col.5 line 15-col.6 like 39; Pepe Fig.1 and Fig.41-Fig.44);

a text-to-speech converter for converting the text data into audio data (Zahavi col. 5 line

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15-col.6 line 39; Pepe col.21 *lines 45-54 and col.29 line 26-col.30 line 56*); a controller which includes: a means for originating a call of a telephone number when the telephone number and a call up setup are inputted from the key-input section, a means for reading out the text data stored in one of the memories on receipt of a signal sent from the base station corresponding to a response of a called party to the call and supplying the text data to the text-to-speech converter in order to convert the text data to audio data, a means for sending the converted audio data to the radio transmitter/receiver, a means for displaying contents of the text data on a display during the transmission; and a means for terminating the call or disconnecting after the transmission of the converted audio data is completed and a means for designating the readout of the text data during the call including the prescribed period of time(Zahavi Fig.2 col. 5 line 15-col.6 line 39; Pepe Fig.1 col.21 *lines 45-54 and col.29 line 26-col.30 line 56*).

#### ***Allowable Subject Matter***

4. In view of the IDS and '112' issues above, Claims 19-22 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 2, 3-4, 6-10, 12-14, and 16-22 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's arguments regarding the prior art of record, Zahavi, not

teaching the added limitation of "...the prescribed period of time", It is noted that this limitation does not refer to an earlier 'prescribed period of time' and therefore it is not known what prescribed time it is referring to. Examiner interprets this period of time as any time designated by the sender until further clarification/correction by the applicant.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP  
May 31, 2004

*JTP*

*Allan Hoosain*  
ALLAN HOOSAIN  
PRIMARY EXAMINER  
*for*  
*Fan Tsang*